

ESTTA Tracking number: **ESTTA680081**

Filing date: **06/25/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	Federation of the Swiss Watch Industry FH
Granted to Date of previous extension	06/28/2015
Address	Rue d'Argent 6 Bienne, CH-2501 SWITZERLAND

Attorney information	Rachel Hofstatter Step toe & Johnson LLP 1330 Connecticut Avenue, NW Washington, DC 20036 UNITED STATES rhofstatter@step toe.com, wpecau@step toe.com, ipdocketing@step toe.com Phone: 202-429-3000
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### Applicant Information

Application No	86346299	Publication date	12/30/2014
Opposition Filing Date	06/25/2015	Opposition Period Ends	06/28/2015
Applicant	Walter R. Thomas Inc 2891 N. Druid Hills Road Atlanta, GA 30329 UNITED STATES		

### Goods/Services Affected by Opposition

Class 014. First Use: 2014/02/24 First Use In Commerce: 2014/03/24  
All goods and services in the class are opposed, namely: Watches and clocks

### Grounds for Opposition

Deceptiveness	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
The mark is primarily geographically deceptively misdescriptive	Trademark Act section 2(e)(3)

### Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	3038819	Application Date	08/16/2002
Registration Date	01/10/2006	Foreign Priority Date	NONE

Word Mark	SWISS MADE
Design Mark	<b>SWISS MADE</b>
Description of Mark	NONE
Goods/Services	Class A. First use: First Use: 1931/00/00 First Use In Commerce: 1931/00/00 HOROLOGICAL AND CHRONOMETRIC INSTRUMENTS, NAMELY, WATCHES, CLOCKS AND THEIR COMPONENT PARTS AND FITTINGS THEREOF

U.S. Registration No.	3047277	Application Date	08/16/2002
Registration Date	01/24/2006	Foreign Priority Date	NONE
Word Mark	SWISS		
Design Mark	<b>SWISS</b>		
Description of Mark	NONE		
Goods/Services	Class A. First use: First Use: 1931/00/00 First Use In Commerce: 1931/00/00 HOROLOGICAL AND CHRONOMETRIC INSTRUMENTS, NAMELY, WATCHES, CLOCKS AND THEIR COMPONENT PARTS AND FITTINGS THEREOF		

Attachments	76442497#TMSN.png( bytes ) 76442496#TMSN.png( bytes ) Z ZANDER SWISS & Design Notice of Opposition.pdf(80016 bytes )
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### Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Rachel Hofstatter/
Name	Rachel Hofstatter
Date	06/25/2015

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE  
TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial No. 86/346,299  
Published in the Official Gazette on December 30, 2014

FEDERATION OF THE SWISS WATCH INDUSTRY FH)	)	
Opposer,	)	
v.	)	
WALTER R. THOMAS INC.,	)	Opposition No. _____
Applicant.	)	

**NOTICE OF OPPOSITION**

Federation of the Swiss Watch Industry FH (the “Swiss Watch Federation”), an unincorporated association formed under the laws of Switzerland, having an address at Rue d’ Argent 6, CH-2501, Bienne, Switzerland, believes it will be damaged by registration of the mark Z ZANDER SWISS & Design, Application Serial No. 86/346,299, and, having previously obtained an extension of time up to and including June 28, 2015, to oppose the application, hereby opposes the same.

As grounds for the opposition, it is alleged that:

1. The Swiss Watch Federation is a non-profit association comprised of more than 500 members of the Swiss watch industry. The Swiss Watch Federation includes among its members such renowned and famous watch manufacturers as Rolex, Breitling, Omega, Cartier, Longines, Baume & Mercier, Gucci, Movado, Omega, and Piaget. The Swiss Watch Federation has authority under the Swiss Federal Law on the Protection of Trademarks and Indications of Source and its by-laws to enforce the rights in indications of Swiss geographic origin, such as the

flag of the Swiss Confederation, the Swiss Coat of Arms and the terms SWISS, SWISS MADE and SWITERZLAND in connection with watches and other horological instruments. The Swiss Watch Federation's responsibilities include certifying Swiss origin of watches and other horological instruments and protecting throughout the world the Swiss identity of watches and other horological instruments and combating infringements throughout the world of Swiss geographical designations.

2. Watches and other horological instruments made in Switzerland enjoy a substantial prestige and salability and are considered quality products throughout the world, including the United States.

3. Since long prior to February 24, 2014, the first use date anywhere claimed in the application that is the subject of this Notice of Opposition, and March 24, 2014, the first use date in US commerce in such application, the designations SWISS and SWISS MADE have been famous and distinctive appellations of origin of watches and horological instruments made in Switzerland pursuant to the Swiss Watch Federation's certification standards which have been established by Swiss law. Since long prior to February 24, 2014, the first use date anywhere claimed in the application that is the subject of this Notice of Opposition, and March 24, 2014, the first use date in US commerce in such application, consumers in the United States have come to know the SWISS and SWISS MADE certification marks as denoting watches that originate from Switzerland. As a result of their long use, renown and recognition in the United States, the SWISS and SWISS MADE marks are now, and since long before the filing date of Applicant's intent-to-use application herein opposed, famous certification marks. The Swiss Watch Federation has exclusive control over the use in commerce in the United States of the SWISS and SWISS MADE certification marks in connection with watches and horological instruments.

4. The Swiss Watch Federation's certification standards for a SWISS or SWISS MADE watch have been established by Swiss law which defines the standards for a watch of Swiss origin. Under the Swiss Federal Ordinance Governing the Use of the Appellation "Switzerland" or "Swiss" for Watches (the "Ordinance"), a watch may be considered as Swiss and may be indicated as such only if: (1) its movement is Swiss; (2) its movement is cased up in Switzerland; and (3) the manufacturer carries out the final inspection in Switzerland. A movement is considered Swiss if: (1) it has been assembled in Switzerland; (2) it has been inspected by the manufacturer in Switzerland; and (3) the components of Swiss manufacturer make up at least 50% of the value of the movement without considering the costs for assembly. Watches that do not meet these standards may not be labeled with any appellation which indicates Swiss origin. A copy of the Ordinance is attached as Exhibit A.

5. As part of its charter to protect symbols of Swiss origin for watches and other horological instruments, the Swiss Watch Federation has obtained U.S. Registration No. 3,047,277 for the certification mark SWISS and U.S. Registration No. 3,038,819 for the certification mark SWISS MADE for "horological and chronometric instruments, namely, watches, clocks and their component parts and fittings thereof." These certification marks certify watches of Swiss origin. The Swiss Watch Federation's certification mark registrations for the marks SWISS and SWISS MADE are and continue to be valid, subsisting, unrevoked, uncanceled and in full force and effect, and the Swiss Watch Federation is still the owner of each of the registrations and the certification marks shown therein.

6. By the application herein opposed, Applicant seeks to register Z ZANDER SWISS & Design as a trademark for "watches and clocks" in International Class 014 ("Applicant's Goods") under Application Serial No. 86/346,299.

7. The description of Applicant's Goods is not limited to watches that are of Swiss origin and that meet the standards the Swiss Watch Federation uses to certify watches as being of Swiss origin.

8. Upon information and belief, Applicant manufactures and sells watches that do not meet the standards the Swiss Watch Federation uses to certify watches as being of Swiss origin and therefore are not of Swiss origin. Accordingly, in selecting the Z ZANDER SWISS & Design mark, Applicant intends to falsely suggest its watches so marked are made in Switzerland.

9. Applicant uses the Z ZANDER SWISS & Design mark in connection with watches, the identical kind of goods that the Swiss Watch Federation's members and other manufacturers of watches of Swiss origin sell in the United States. Applicant's Goods are sold to the same kinds of customers and through the same channels of trade that the Swiss Watch Federation's members and other manufacturers of watches of Swiss origin sell their watches.

10. When used in connection with Applicant's Goods, consumers will falsely believe that the Z ZANDER SWISS & Design mark signifies and identifies a watch that originates from Switzerland. And, by reason of the use of the Z ZANDER SWISS & Design mark in connection with Applicant's watches, consumers are likely to believe that they are purchasing genuine Swiss watches originating from Switzerland, when, upon information and belief, they are not.

11. Because watches made in Switzerland are renowned for their quality and precision and are endowed with significant goodwill, the geographical indication of a watch of Swiss origin is a material consideration in a consumer's purchase decision.

12. Applicant's Z ZANDER SWISS & Design mark so nearly resembles the

Swiss Watch Federation's SWISS and SWISS MADE certification marks as to be likely, when used in connection with Applicant's Goods, to cause confusion, to cause mistake, with consequent injury to the Swiss Watch Federation, the Swiss Watch Federation's members, those who are authorized by the Swiss Watch Federation to use the SWISS and SWISS MADE certification marks, and the public, in violation of Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).

13. When used in connection with Applicant's Goods, which upon information and belief do not originate from Switzerland, the Z ZANDER SWISS & Design mark is a geographically deceptive mark in violation of Section 2(a) of the Trademark Act, § 15 U.S.C. 1052(a).

14. When used in connection with Applicant's Goods, which upon information and belief do not originate from Switzerland, the Z ZANDER SWISS & Design mark is primarily a geographically deceptively misdescriptive mark in violation of Section 2(e)(3) of the Trademark Act, § 15 U.S.C. 1052(e)(3).

15. The Swiss Watch Federation will be damaged by the registration sought by Applicant because such registration will support and assist Applicant by giving color of exclusive statutory rights to Applicant in the Z ZANDER SWISS & Design mark for watches not limited to those of Swiss origination in violation and derogation of the Swiss Watch Federation's rights to its SWISS and SWISS MADE certification marks and will support Applicant in the confusing, misleading, and deceiving use of its mark indicating Swiss origin for watches that, upon information and belief, do not originate from Switzerland, all to the detriment and damage of the Swiss Watch Federation, the Swiss Watch Federation's members, those who are authorized by the Swiss Watch Federation to use the SWISS and SWISS MADE certification marks, and the public.



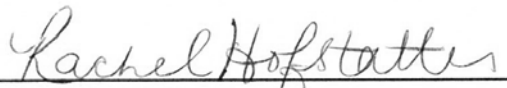
WHEREFORE, the Swiss Watch Federation believes that it will be damaged by the registration of Applicant's mark and prays that Application Serial No. 86/346,299 be denied pursuant to Sections 2(a), 2(d) and 2(e)(3) of the Trademark Act of 1946, 15 U.S.C. §1052(a), (d) and (e)(3).

Please recognize as attorneys for the Swiss Watch Federation in this proceeding William G. Pecau (a member of the bars of the states of New York and California, and the District of Columbia) and Rachel M. Hofstatter (a member of the bars of the State of Maryland and the District of Columbia), whose address is Steptoe & Johnson LLP, 1330 Connecticut Avenue, NW, Washington, D.C. 20036. Please address all communications to William G. Pecau, Esq. at the above address. If any additional fees are due in connection with this filing, please debit our Deposit Account No. 19-4293 and provide us with a receipt.

Dated: June 25, 2015

Respectfully submitted,

**STEPTOE & JOHNSON LLP**

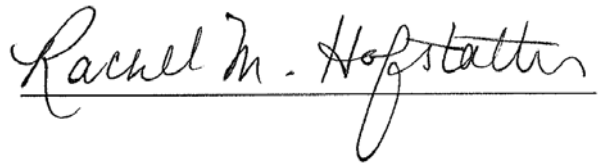
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*Attorneys for Opposer, Federation of the  
Swiss Watch Industry FH*

**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing NOTICE OF OPPOSITION has been served on Applicant Walter R. Thomas Inc. on this 25th day of June, 2015 by first class mail, postage prepaid addressed as follows:

Mr. Jefferson Alexander  
CEO  
Walter R. Thomas Inc.  
2891 N. Druid Hills Road  
Atlanta, GA 30329

  
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